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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/826,671

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Michael Chen

BPCUR0007MC (C-52)

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02/20/2009

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EXAMINER

PARRA, OMAR S

ART UNIT

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/826,671	<b>Applicant(s)</b> CHEN ET AL.	
	<b>Examiner</b> OMAR PARRA	<b>Art Unit</b> 2421	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 10 December 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1,4-11,13,18-25,27-32,37,38,41-43 and 48-51 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 4-11, 13, 18-25, 27-32, 37, 38, 41-43 and 48-51 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 12/10/2008 has been entered.

### ***Response to Arguments***

Applicant's arguments with respect to claims 1, 4-11, 13, 18-26, 27-32, 37, 38, 41-43 and 48-51 have been considered but are moot in view of the new ground(s) of rejection.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims **1, 4-10, 13, 18-25, 27-32, 37, 38, 41-43 and 48-50** are rejected under 35 U.S.C. 102(e) as being anticipated by Plotnick et al. (hereinafter 'Plotnick', Pub. No. 2002/0184047).

Regarding claims 1, 25 and 27, Plotnick teaches an apparatus for creating at least one targeted integrated image for delivery to a user **(130, Fig. 1; [0037]; [0039]; where the content provider 130 selects advertisements and send them along with the content, [0085])**, the apparatus comprising:

a processor for determining content of potential interest to the user based on at least one user preference **(The ads for selection are placed in queue or playlist from which the headend picks commercials. This queue includes targeted commercials that include at least one user preference, [0087]; [0101]; [0105]-[0106]).** Given that the data to generate the queue -Universal Ad Queue, UAQ- is retrieved from a database and that the ads have pointers to be selected,[0039; [0057], it is inherent that at least one computer processor has to perform all the **selection of the targeted ads)**, prior to or during the user's request for a first image comprising a video file or while the user is receiving the first image **(The selection of ads can be dynamic or it can follow a predetermined order of insertion, [0055]; [0556]; [0059]),** and selecting a second image comprising a barker advertising the content of potential interest to the user **(different type of advertisements are chosen to be combined to the content: overlay ads, advertisement bugs, product placement ads, programming ads, VoD or PPV ads, etc, which are selected from the UAQ for presentation and put together with the content, [0047]-[0050]),** and wherein the processor determines the content of potential interest to the user that has not previously been viewed by the user **(One of the features of the UAQ is that it**

Art Unit: 2421

**keeps track of what ad was already played and puts it at the end of the queue to make sure it does not repeat and other fresh ad is played next, [0058]; [0061]);**

a combiner for combining the second image with the first image to form an targeted integrated image for delivery to the user ([0012]; [0047]-[0050]; [0085]; [0109], where ads are inserted in the delivered content, and therefore, an inherent inserter or combiner must exist) and wherein the combiner inserts the second image within the first image, wherein the first image or the third image is adapted to appear as a picture-in-picture display with the barker advertising the content of potential interest to the user presented as a first picture within a second picture of the video file (**For trick play content -content that allow pausing, rewind, skip, etc- an alternate advertisement –video ad- is presented on top of the tricked video file as a picture-in-picture, [0139]-[0140]. The PVR functions can be implemented entirely at the headend [0121]).**

Additionally, Plotnick teaches that the at least the one user preference comprises content ordering habits of the user ([0101]; [0104]; [0105]).

Regarding claims 4 and 28, Plotnick teaches wherein content ordering habits includes at least one of information indicating times at which the user previously viewed or ordered content, genres of content previously viewed or ordered by the user, characteristics of content previously viewed or ordered by the user, and menu selections made by the user (**Plotnick: [0083]; [0084]; [0101]; [0104]; [0105]).**

Regarding claims 5 and 29, Plotnick teaches further comprising determining an identity of the user, wherein the content of potential interest to the user is determined based on an at least one user preference associated with the identity of the user **(Plotnick: the ads of the queues are generated for a specific subscriber, 1 or 2, Fig. 20; [0148]-[0149])**.

Regarding claims 6 and 30, Plotnick teaches wherein the step of selecting selects the second image from a queue **(Plotnick: the advertisements are selected from a universal ad queue; title; abstract)**.

Regarding claims 7 and 31, Plotnick teaches further comprising:  
determining content previously ordered or viewed by the user **(Plotnick: [0083]; [0084]; [0101]; [0104]; [0105])**;

determining images available in the queue **(advertisement on the queue are available for presentation; [0055]-[0059])**; and

removing images related to the previously ordered or viewed content from the queue **(advertisement already viewed for a given number of times are removed from the queue; [0061]; [0081])**.

Regarding claims 8 and 32, Plotnick teaches further comprising: marking the second image delivered to the user as having been delivered; and placing the marked image at the end of the queue, wherein the step of selecting selects images sequentially

Art Unit: 2421

from the beginning of the queue (**Plotnick: [0055]; [0056]; [0061]; where the ads will be played in order unless there is a preference or weight for their presentation, at least in [0059]-[0060]).**

Regarding claim 9, Plotnick teaches wherein the first image includes at least a menu or a programming guide (**Plotnick: [0051]; [0055]; [0056]).**

Regarding claim 10, Plotnick teaches wherein the step of determining is initiated in response to the user accessing the menu or programming guide (**Plotnick: [0056]).**

Regarding claims 13 and 37, Plotnick teaches wherein the step of determining is initiated responsive to the user requesting the video content (**Plotnick: [0038]-[0039]; [0047]-[0050]; [0059]; .**

Regarding claims 18,19, 38, 41 and 42, Plotnick teaches further comprising repeating the steps for creating at least one new integrated image for delivery to the user as the user continues to request or receive images (**As seen on Fig. 20, the integration of ads is repeated while the subscriber 1 keeps watching ABC. Given that queues are used for integrating commercials to content, and given that there is a plurality of ads in a queue, the process of integrating the ads and content has to repeat at least once more; [0054]-[0055]; [0059]).**

Art Unit: 2421

Regarding claims 20 and 43, Plotnick teaches wherein the steps are recursively repeated for delivering new integrated images for delivery to the user **(The UAQ is generated periodically, [0081], and therefore, the integration of ads and content for delivery is repeated recursively).**

Regarding claim 21, Plotnick teaches further comprising compressing at least one of the first image or the second image, prior to forming the integrated image **([0045]).**

Regarding claim 22, Plotnick teaches wherein the step of combining includes inserting the second image within the first image wherein the first image is adapted to appear to the user to be paused **([[0139]-[0140]).**

Regarding claim 23, Plotnick teaches wherein the first image is adapted, for delivery to the user, to appear to be paused **(The PVR functions can be performed at the headend [0121]; therefore, the video content is delivered trick-played, i.e. paused, [0139]-[0140]).**

Regarding claim 24, Plotnick teaches wherein the first image is adapted, upon delivery to the user, to appear to be paused **(The PVR functions can be performed at the user subscriber's location [0121]; therefore, the trick play features are**



**performed at the local PVR, and the content is not delivered like that, i.e. paused, [0139]-[0140]).**

Regarding claim 48, Plotnick teaches wherein the integrated image is configured to appear as a picture-in-picture display in accordance with predetermined rules **(On VoD or PPV content, picture-in-picture ads are presented following certain rules, [0138]-[0140]).**

Regarding claim 49, Plotnick teaches wherein the predetermined rules comprise presenting the barker advertising the content of potential interest to the user during an introduction of the video file **(VoD or PPV ads can be presented before the program or at the end of the program [0048]).**

Regarding claim 50, Plotnick teaches wherein the predetermined rules comprise presenting the barker advertising the content of potential interest to the user during credits of the video file **(VoD or PPV ads can be presented before the program or at the end of the program [0048]).**

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

Art Unit: 2421

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claim **11** is rejected under 35 U.S.C. 103(a) as being unpatentable over Plotnick et al. (hereinafter 'Plotnick', Pub. No. 2002/0184047) in view of Knudson et al. (hereinafter 'Knudson', Pub. No. 2003/0110499).

Regarding claim 11, Plotnick teaches all the limitations of the claim it depends on. On the other hand, although Plotnick teaches determining ads based on user's viewing habits, Plotnick does not explicitly teach monitoring user's menu or programming guide selections as the user navigates through the menu or programming guide.

However, in an analogous art, Knudson teaches a system for targeting advertisement to users (title; Abstract; [0011]). In order to target advertisement to users, Knudson teaches to monitor all the interactions of the user with the program guide ([0011]; [0071]), since the user's interactions with the program guide are indicative of the user's interest ([0005]). Knudson teaches that one of the user's monitored actions is the user navigation on the EPG ([0072]).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Plotnick's invention with Knudson's monitoring of user's navigation interaction with the program guide for the benefit of using all or as many of the resources to get user's preference for a more accurate advertisement targeting.

Art Unit: 2421

6. Claim **51** is rejected under 35 U.S.C. 103(a) as being unpatentable over Plotnick et al. (hereinafter 'Plotnick', Pub. No. 2002/0184047) in view of Sie et al. (hereinafter 'Sie', Pub. No. 2004/0030599).

Regarding claim 51, Plotnick teaches all the limitations of the claim it depends on. On the other hand, Plotnick does not explicitly teach wherein the barker advertising the content of potential interest to the user has a first genre associated therewith, wherein the video file has a second genres associated therewith, wherein the determining content of potential interest to the user based on at least one user preference comprising content ordering habits of the user comprises selecting the first genre so as to be different from the second genre.

However, in an analogous art, Sie teaches a system that integrates served content with commercials (Abstract). Sie teaches monitoring user viewing habits and being able receive user's inputs ([0086]-[0090]). Sie teaches categorizing commercials, and if it is determined that the commercial should not be presented according to user's profile, even if a content with that category is chosen, a commercial under that category will be automatically skipped and will not be chosen, and instead, another commercial will be utilized ([0150]-[0151]).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Plotnick's invention with Sie's feature of automatically not choosing or skipping a commercial when the category of the commercial and the content are the same and not allowed for the benefit of not showing

Art Unit: 2421

commercials with categories not allowed when a program disliked by the user has been selected by mistake.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to OMAR PARRA whose telephone number is (571)270-1449. The examiner can normally be reached on 9-6 PM (M-F, every other Friday off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John W. Miller can be reached on 571-272-7353. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/John W. Miller/  
Supervisory Patent Examiner, Art Unit 2421

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Application/Control Number: 10/826,671  
Art Unit: 2421

Page 12